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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,857	05/14/2001	Lance E. Brothers	HES 99.0350U1C1	1002

7590 02/27/2003

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EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 02/27/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,857

Applicant(s)

BROTHERS ET AL.

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Applicant's arguments filed 2/20/03 have been fully considered but they are not persuasive.

35 USC 103 Rejection:

Claims 21-40 remain rejected under 35 U.S.C. 103(a) as obvious over Reddy et al. (US 6,273,191B1) alone or in view of Cowan et al. '991 or Gilbert et al. '866.

Reddy et al. teach cement composition comprising calcium aluminate cement, accelerator, retarder, water, as well as foam forming and foam stabilizing surfactants thus anticipating the instant invention. Even if not anticipated, Reddy would appear to teach the same components in overlapping amounts. Cowan et al. and Gilbert et al. would appear to teach that the use of lithium salts as accelerators for aluminous cements including those used for subterranean formations would have been obvious to one of ordinary skill in the art. Note that in column 7, first paragraph Reddy et al. teach that a variety of cement set accelerators may be used, calcium salt accelerators such as calcium chloride, calcium nitrite, and calcium formate are preferred. A reference, however, is good for all that it realistically teaches and is not limited to the preferred embodiments. Lithium salts were known at the time of applicants' invention for use in subterranean formations and for aluminous cements and the use of other known or conventional accelerators in the Reddy et al. cement composition would have been obvious to one of ordinary skill in the art because they were known accelerators for subterranean formations at the time of applicants invention.

The applicants' amendment necessitated the new grounds of rejection:

Claims 21-40 are rejected under the first paragraph of 35 USC 112 and 35 USC 132 because the specification as originally filed does not provide support for the invention as is now claimed.

The terms "comprised substantially of calcium aluminate" would appear to be new matter because there is no literal support for cement other than calcium aluminate nor is there any mention in the specification of *substantial* amounts.

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Claims 21-40 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The terms "comprised substantially of" calcium aluminate would appear indefinite because applicants do not particularly point out with this language how much is actually considered a "substantial amount". Is a substantial amount 1%, 5%, 99%? There is no guidance either from the specification as to what applicants may consider a substantial amount. This term is thus indefinite.

Response:

The applicants have stated that the examiner suggested adding "comprised substantially of calcium aluminate". In rebuttal, the applicants' statement that the examiner suggested anything of the kind is not true because the examiner never suggested any action to applicants. A review of this previous office action indicates that.

The applicants' usage of "comprised substantially of calcium aluminate" would appear to be new matter and indefinite. Applicants do not have support for "substantially of calcium aluminate" nor do they particularly point out exactly how much is considered a substantial amount.

The applicants also argue that Reddy '191 teaches in column 9, lines 57-59 that calcium aluminate cement is present in the amounts of 0.5% to 5% by weight yet they "claim" a foamed cement composition having an amount of greater than about 5% by weight. In rebuttal, the applicants argue limitations not present in their own claims.

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Where in any of the independent claims is there a limitation that the amount of calcium aluminate of applicants' invention is greater than 5 wt%? There is no such limitation in any of their claims. Further, how does applicants come to the position that a "substantial amount" equates to an amount greater than 5% and thus teaching away from Reddy? A substantial amount can potentially be an amount below 5% and thus very much in the range of the prior art. The problem is the applicant cannot hold the term substantial to overcome the prior art because this term is not a numerical limitation. Had applicants used numerical ranges, it may have been convincing but only using the term substantial does not overcome the overlap in the prior art amounts of calcium aluminate cement.

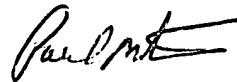
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is (703)-308-1196. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703) 308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Paul Marcantoni
Primary Examiner
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